

Kratz, Quintos & Hanson, LLP – IP Newsletter

SUPPLEMENTAL EXAMINATION

By: Darren Crew

Supplemental Examination can be useful, in some circumstances, because it can enable a patent owner to provide the U.S. Patent and Trademark Office (U.S. PTO) with information in an effort to protect the patent owner against future charges of inequitable conduct and/or to make a clearer showing of validity.

However, please note that there can be some potential disadvantages associated with Supplemental Examination. For example, a fee of \$16,500 must be submitted when the Supplemental Examination is filed, for a large entity. Also, if the U.S. PTO determines that the newly submitted material raises a substantial new question of patentability, then an *ex parte* reexamination is ordered and this could require two additional years of prosecution (or more) before the process is concluded.

When filing a Supplemental Examination, it is important to be sure to include at least the following:

- (1) An identification of the number of the patent;
- (2) A list of the items of information that are requested to be considered;
- (3) A list identifying any other prior or concurrent post-patent Office proceedings involving the patent for which supplemental examination is being requested, including an identification of the type of proceeding, the identifying number of any such proceeding (for example, a control number or reissue application number), and the filing date of any such proceeding;

- (4) An identification of each claim of the patent;
- (5) A separate, detailed explanation of the relevance and manner of applying each item of information to each claim of the patent for which supplemental examination is requested;
- (6) A copy of the patent for which supplemental examination is requested and a copy of any disclaimer or certificate issued for the patent;
- (7) A copy of each item of information, accompanied by a written English translation of all of the necessary and pertinent parts of any non-English language item of information;
- (8) A summary of the relevant portions of any submitted document that is over 50 pages;
- (9) An identification of the owner of the entire right in the patent requested to be examined;
- (10) Submission of fee (for a large entity, for example, \$16,500 must be submitted to the U.S. PTO, and \$12,100 will be refunded if a substantial new question of patentability is not found); and
- (11) Submission of U.S. PTO Form PTO/SB/59.

If you have any questions, please do not hesitate to contact our office.

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